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OFFICE OF PETITIONS

In re Application of
English
Application No. 10/727,139
Filed: 2 December, 2003
Attorney Docket No. CDPC-011

ON PETITION

This is a decision on the petition under ¶(b) of 37 C.F.R. §1.47, filed on 7 October, 2004.

The petition is **DISMISSED**.

NOTE: Any petition (and fee) for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventors.

Thereafter there will be no further reconsideration. Failure to respond will result in abandonment of the application.

BACKGROUND

The record indicates:

- this application was filed on 2 December, 2003, without, *inter alia*, an executed oath or declaration by the named inventor;
- accordingly, on 4 March, 2004, the Office mailed a Notice of Missing Parts;

- in response to the Notice of Missing Parts, Petitioner filed the instant petition (over a 4 October, 2004, certificate of mailing) on 7 October, 2004 (with a request and fee for a five- (5-) month extension of time and the surcharge) by Petitioner Edward J. Kelley (Reg. No. 38,936)—while Petitioner alleges transmission of the entire application (specification, claims and drawings) to the non-signing inventor Daniel W. English (Mr. English), Petitioner fails to provide a copy of the transmittal letter in support of the allegation and fails to make and support allegation of rights/interest in the application and risk of irreparable harm/damage.

Moreover, Petitioner failed to include a signed oath/declaration executed by an authorized executive of the alleged assignee on behalf of the non-signing inventor.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

* * *

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including

the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted (a reasonable effort must be made to ascertain a current or last known address)--but also the petition must state over the signature and registration number of the Petitioner the last known address (and, if appropriate, evidence of the due diligence effort ascertaining same). Moreover, Petitioner must make and support allegations of rights/interest in the application and of risk of irreparable harm/damage.

Finally, Petitioner must include a signed oath/declaration executed by an authorized executive of the alleged assignee on behalf of the non-signing inventor.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

CONCLUSION

Therefore, the instant petition must be and hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents²
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306 (IFW Formal Filings)

¹ See: MPEP 409.03(b).

² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



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Office of Petitions